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REMARKS

Claims 24-46, 50 and 51 were rejected under §103(a) as being obvious over 6 487 599 to Smith et al in view of 4 955 066, Notenboom, or 5 109 433, Notenboom2, or 5 999 949, Crandall. These rejections are untenable for the following reasons.

Claims 24-46

The disclosure of the present application clearly describes a form of learning by the system of the present invention. This form of learning includes searching through the stored material and counting how frequently various phrases and sentences are used, and substitutes a short code identifying the phrase. (Page 11, line 24 to page 12, line 4.) Furthermore, the system can run comparisons repeatedly, at chosen times or set intervals, to find identical sentences which can then be replaced by short codes.

This concept is claimed in Claim 24 at lines 7-11, i.e.,

"repeatedly and automatically reviewing the text content of output documents to identify phrases that are repeatedly used and which can be replaced by a shorter access code, thereby reducing the volume of unique data to be added to the output documents."

The prior art of record does not disclose this concept. It is known to conduct a review of a document at the outset of a compression process to find such redundancy, but there is no suggestion of repeatedly and automatically conducting such

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reviews or comparisons.

It was recognized in ¶8 of the Action that Smith does not teach repeatedly and automatically reviewing the content of output documents to identify content that is repeatedly used and which can be replaced by a shorter access code, thereby reducing the volume of unique data to be added to the output documents.

Regarding the Notenboom references, it was said in the Action that each of Notenboom and Notenboom2 teach reviewing the content of output documents to identify content that is repeatedly used and which can be replaced by a shorter access code, thereby reducing the volume of unique data to be added to the output documents. (Fig. 1, block 6; col. 1 lines 60-63; col. 3, lines 48-61 of Notenboom; and, in Notenboom2, Fig. 1, block 16; col. 1, lines 66-68; col. 3, lines 55-68.)

The Action did not say that either Notenboom nor Notenboom2 teach repeatedly and automatically reviewing the content of output documents to identify content that is repeatedly used and which can be replaced by a shorter access code, thereby reducing the volume of unique data to be added to the output documents. Thus, the rejection based on Smith and either Notenboom or Notenboom2 fails to make the claim language obvious under §103a.

It was said that, citing case law, "[I]t has been held that one of ordinary skill would recognize the benefits of repeating steps and performing them automatically," and that this language in Applicant's claims would therefore have been obvious.

It is submitted that this rejection is untenable for the following reasons.

A careful review of Notenboom and Notenboom2 reveals that they use an initial review of the text to see if there is anything

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repeated which can be replaced. This is only done once. For whatever reason, no further review is done either automatically nor manually, nor does the Action suggest that it is done.

#### Cited Case Law

As to the cited case law, it is not clear why *In re Harza*, 74 2F.2d 669, (CCPA, 1960) was cited. The opinion in *Harza* has nothing to do with repeating steps or performing them automatically. *Harza* involved an appeal of claims directed to a water stop or barrier designed to be positioned so that concrete or the like could be poured, in successive steps, on opposite sides of an elastic membrane having offset, specially shaped ribs. As the concrete is poured on the first side, the ribs on that side are immersed in the concrete. When the concrete is poured on the second side, the ribs on the second side are similarly immersed. When the concrete cures, shrinkage occurs and the masses of concrete separate, but the specially shaped ribs remain encased and connected to the respective masses.

The court considered an issue of duplication of parts which was said to have no patentable significance and concluded that some of the claims were properly rejected. It went on to find that other claims distinguished over the prior art and were improperly rejected. No issues involving repeating steps or performing them automatically were considered or decided by the court. *Harza* therefore appears to be quite irrelevant to the rejection and to the pending claims and will be hereinafter disregarded. If the Examiner regards this case as being somehow relevant, clarification is requested.

*In re Venner et al*, 262 F.2d 91 (CCPA, 1958) was also cited to

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support the proposition in the Action that, "[O]ne of ordinary skill in the art would recognize the benefits of repeating steps and performing them automatically." However, it is submitted that this case does not support that proposition, as stated, and that the proposition itself differs so significantly from the claim language that, even if the case supported the stated proposition, it would not support a valid rejection.

*Venner* deals with claims directed to an apparatus for molding a particular kind of pistons out of aluminum and magnesium alloys. The apparatus has two external horizontally moveable outer mold sections, a pair of internal horizontally displaceable side core sections, and a vertically acting middle core section which can be withdrawn by a fluid motor. The problem which is allegedly solved by the invention relates to the time of withdrawing that middle core section during cooling. It must be withdrawn at exactly the right time: if it is withdrawn too early, the material slumps, and if too late, there is excessive shrinkage.

Before the claimed invention, the middle core section was withdrawn by manually actuating the fluid motor when, in the judgment (or guesswork) of an operator, the cooling has progressed to just the right point. However, human error in operator judgment resulted in a high rate of rejections of pistons. Therefore, the claimed invention added time-controlled means to actuate the fluid motor. The time-controlled means was set to the period between completion of pouring of the metal in the mold and solidification of the metal therein.

The court found that the prior art included all of the apparatus except for the timer and solenoid which automatically actuates the [known] pressure valve system to move the inner core

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after a predetermined time had elapsed. The court stated, "[I]t is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity *which has accomplished the same result*", citing *In re Rundell*, 18 CCPA 1290, 48 F 2d 958, 9 USPQ 220. The rejection of the claims was therefore upheld.

It is submitted that the language of this decision, as quoted above, clearly says that if an automatic means is simply substituted for manual activity which theretofore has accomplished the same result and the automatic means, then there is no patentability in providing the automatic means. The *Venner* opinion has nothing to say about repeatability.

However, the present invention presents a quite different situation from *Venner*. In the present case, the prior art does not disclose a system which provides for repeatedly reviewing the text content of output documents to identify phrases that are repeatedly used and which can be replaced by a shorter access code, whether that repeated reviewing is done manually or automatically. Thus, the automatic reviewing does not replace manual activity which has accomplished the same result, the *Venner* opinion is not controlling, and the combination of references therefore does not provide a basis for the rejection of claim 24. Accordingly, it is believed that this claim should now be held allowable.

Claims 25-46 are dependent on claim 24. Thus, although these claims may have features which also distinguish over the cited art, they should be held allowable with claim 24.

Smith et al and Crandall

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As to the combination of Smith et al with Crandall, exactly the same situation applies. Crandall uses an initial review to find duplication of phrases or sentences, but there is no suggestion of repeatedly accomplishing such a review, either manually or automatically. Thus the combination of Smith et al with Crandall also fails as a proper basis for rejection of claims 24-46 under §103(a).

Claims 50 and 51

Claim 50 is independent and includes the same language referred to above regarding repeatedly and automatically reviewing the content of output documents to identify content that is repeatedly used. Accordingly, Claim 50 should be allowable for the same reasons as given above with reference to claims 24-46.

Claim 51 is dependent on claim 50 and should be allowable with claim 50.

Claims 47 and 48

In ¶62 of the Action, claims 47 and 48 were rejected as being unpatentable over the combination of Smith in view of Notenboom, Notenboom2 or Crandall and further in view of Suzuki et al. Claims 47 and 48 are ultimately dependent on Claim 24 which should be allowable for the reasons discussed above. Suzuki does not show, nor was it alleged to show, repeatedly and automatically reviewing content of output documents. Thus, whatever else Suzuki may show, it does not contribute to a meaningful rejection of claims 47 and 48, and those claims should therefore be held allowable.

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Claims 52 and 53

In ¶69 of the Action, claims 52 and 53 were rejected as being unpatentable over the combination of Smith in view of Notenboom, Notenboom2 or Crandall and further in view of Perry et al. Claims 52 and 53 are ultimately dependent on Claim 24 which should be allowable for the reasons discussed above. Perry does not show, nor was it alleged to show, repeatedly and automatically reviewing content of output documents. Thus, whatever else Perry may show, it does not contribute to a meaningful rejection of claims 52 and 53, and those claims should therefore be held allowable.

CONCLUSIONS

For the reasons given herein, it is submitted that the claims now existing in this application are allowable over the art of record, considered singly or in any proper combination, and such action is respectfully requested.

Respectfully submitted,



Walter C. Farley  
Reg. No. 22,624  
Attorney for Applicant

P.O. Box 329  
Harpwell ME 04079  
Fax 207 833 7831  
Tel 207 833 6810  
wfarley@verizon.net